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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,984	07/11/2003	John F. Krumme	003534-106	2785

7590 04/29/2005

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,984

Applicant(s)

KRUMME, JOHN F.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 8, 11, 13, 15-17, 20, 21 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 14, 18 and 22 is/are rejected.
- 7) ☒ Claim(s) 9, 12 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/05/03; 11/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 04/12/2005 – election.

Claims 1-25 remain pending.

Applicant's election of Group I (claims 1-22) and the species illustrated in Figures 1-7 in the reply filed on 04/12/2005 is acknowledged. The claims to be examined include claims 1-7, 9, 10, 12, 14, 18, 19 and 22. It is noted that claim 19 as written depends from claim 16, which is a non-elected claim. However, a review of claim 19 reveals that claim 19 improperly depends from claim 16, since there is no recitation of a "cavity" in claim 16, as required by the language "the cavity" in claim 19. It would instead appear that claim 19 should depend from claim 18, wherein claim 18 first includes a recitation of the cavity. In this case, even though claim 19 depends from non-elected claim 16, it has been treated as depending from claim 18 for purposes of applying the prior art of record. Applicant is respectfully asked to address this matter and respond accordingly in the next reply. Moreover and because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, ***the election has been treated as an election without traverse*** (MPEP § 818.03(a)).

Claims 8, 11, 13, 15, 16, 17, 20, 21, 23, 24 and 25 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species/invention, there being no allowable generic or linking claim. Election was made **without traverse** (as explained above) in the reply filed on 04/12/2005.

The IDS papers received 12/05/2003 includes two document numbers that do not correspond to the name of the Patentee of the cited document. Specifically, the document identified as 5,322,214 (sheet 2 of 3) does not match with the Patentee named Tucker Sr. The document identified as 4,301 (sheet 1 of 3) does not match with the Patentee named Taylor. Therefore, these two documents have not been considered and the citation has been lined-through. Clarification is respectfully requested.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hardman ('136). Reference is made to Figures 9 and 10 and the discussion in col. 4, lines 12-18. As to claim 1, note Figure 10 showing a faceplate area with a recess therein and further including a plurality of bars (73) in adjacent contact with one another to form a striking surface. As to claim 2, a groove is naturally provided at the juncture between adjacent bars. As to claim 7, the bars are arranged in a vertical direction. As

to claim 14, the bars (73) appear to have the same cross-sectional shape, as evidenced by the cross-sectional appearance of the head in Figure 10.

Claims 1, 2, 6, 7 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chern ('435). Reference is made to Figures 5 and 6 and the discussion in column 2, lines 16-24. As to claim 1, note the plurality of bars or rods (51) that collectively form a striking face (21). The rods are set within a recess in the front striking surface. As to claim 2, grooves are naturally present between adjacent rods. As to claim 6, it would appear that all of the rods are made from the same material that has a high hardness. As to claim 7, the rods are arranged horizontally (Figure 5) or vertically (6) in side-by-side fashion. As to claim 18, the club head is hollow and therefore includes a cavity rearward of the lateral edges of the recess.

Claims 1, 2, 7 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishigaki ('826). Reference is made to Figure 7 and column 3, lines 55-61. As to claim 1, note the plurality of bars comprising alternating laminated ceramic plates and carbon or glass fibers. The laminates bars collectively form a composite block, one face of which serves as a striking surface. As to claim 2, a groove is naturally formed at the juncture of adjoining laminated layers. As to claim 7, the bars are arranged in a horizontal direction. As to claim 14, the laminated bars (layers) appear to have the same cross-sectional shape across their length thereof.

Claims 1, 2, 6, 7, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho ('382). See Figure 4. As to claim 1, it is noted that each segment of the upper layer (44) located between two of the grooves (48) may be considered a bar.

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Hence, Cho shows a plurality of bars that are in adjacent fashion to form a striking surface. As to claim 2, note grooves (48). As to claim 6, the top layer is of the same uniform material throughout. As to claim 7, the bars are generally rectilinear in cross-section and may be arranged in a horizontal direction (Figure 6). As to claim 10, the grooves include beveled edges. As to claim 14, at least some of the bars have the same cross-sectional shape along their lengths.

Claims 3, 4, 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern ('435) in view of Igarashi ('262) and Azzarella ('439). Chern differs from the claimed invention in that Chern does not show interlocking surfaces. Both Igarashi and Azzarella show it to be old to include an arrangement for fitting an insert within the recess portion of a clubface, with Igarashi showing a mating groove arrangement and Azzarella showing a dovetail design. The mating interlocking surface on the actual club head body in both Igarashi and Azzarella is formed in the body. In view of the patents to Igarashi and Azzarella, it would have been obvious to modify the device in Chern to hold the bars (51) within the recess of the striking face using a suitable interlocking arrangement, the motivation being to prevent the bars from shifting during use. As to claims 4 and 5, the uppermost and lowermost bars in the configuration of Figure 5 in Chern provide the top and bottom retainer, respectively, as broadly as claimed. As to claim 22, while Chern selects a high hardness metal for the rods, the skilled artisan would have found it obvious to select a material suitable for the striking face based upon the desired characteristics (i.e., rebound factor, frictional characteristics). The selection

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of a material based upon its natural properties has been deemed to be obvious for the skilled artisan. See In re Hopkins 145 USPQ 140.


Claims 9, 12 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Note the previous comments with respect to the dependency of claim 19, supra.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figures 7-12 in Michaels. Note sections (12, 13, 14) in Pritchett. Onions shows a laminated head.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
April 28, 2005